

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Christian KUNERT et al.

Confirmation No.: 1157

Serial No.: 10/713,050

Examiner: Karl E. GROUP

Filed: November 17, 2003

Group Art Unit: 1755

Title: USE OF A GLASS FOR THERMAL SHOCK-RESISTANT BEVERAGE CONTAINERS

**BRIEF ON APPEAL**

Mail Stop - Appeal Brief - Patent  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as First Class Mail in an envelope addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on: August 24, 2003  
Name: Robert L. Wallenhorst  
Signature: [Signature]

Dear Sir:

**I. Real Party in Interest**

Schott Glas, now Schott AG, is the real party in interest as depicted in an assignment recorded 30 August 2000, with reel/frame no. 011054/0305, in prior application no. 09/532,966, filed 22 March 2000.

**II. Related Appeals and Interferences**

Attached is a Decision mailed 16 September 2003 in prior application no. 09/532,966 related to the present application.

**III. Claim Status**

Pending: 1 - 20.\*  
Rejected: 1 - 20.\*  
Objected: None.  
Allowed: None.  
Withdrawn: None.  
Canceled: None.  
Appealed: 1 - 20.\*

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\*There was no claim 18 in the application as originally filed. Claims 19 - 21 are renumbered as claims 18 - 20.

#### **IV. Status of Amendment**

No amendments were filed after the Final Office Action mailed 24 November 2004.

#### **V. Summary of Claimed Invention**

The invention can relate to a glass including in % by weight, based on oxide:  $\text{SiO}_2$  about 78.5 - about 79.5,  $\text{B}_2\text{O}_3$  about 13.0 - about 14.0,  $\text{Al}_2\text{O}_3$  about 2.0 - about 3.0,  $\text{Na}_2\text{O}$  about 4.5 - about 5.5,  $\text{K}_2\text{O}$  0 - about 0.6, and optionally at least one fining agent; where the glass is colorless (page 2, lines 15-21 and page 3, lines 15-23).

The invention may also relate to a glass comprising in % by weight, based on oxide: about 78.5 to about 79.5  $\text{SiO}_2$ ; about 13.0 to about 14.0  $\text{B}_2\text{O}_3$ ; about 2.0 to about 3.0  $\text{Al}_2\text{O}_3$ ; about 4.5 to about 5.5  $\text{Na}_2\text{O}$ ; and a decolorant (page 2, lines 15-21 and page 3, lines 15-23).

The invention can further relate to a process for making glass comprising melting together: about 78.5 to about 79.5 weight percent based on oxide  $\text{SiO}_2$ ; about 13.0 to about 14.0 weight percent based on oxide  $\text{B}_2\text{O}_3$ ; about 2.0 to about 3.0 weight percent based on oxide  $\text{Al}_2\text{O}_3$ ; and about 4.5 to about 5.5 weight percent based on oxide  $\text{Na}_2\text{O}$ ; where the glass is colorless (page 2, lines 15-21, page 3, lines 15-23, and Example 1 at page 5).

Moreover, the invention may relate to a glass consisting essentially of in % by weight, based on oxide: about 78.5 to about 79.5  $\text{SiO}_2$ ; about 13.0 to about 14.0  $\text{B}_2\text{O}_3$ ; about 2.0 to about 3.0  $\text{Al}_2\text{O}_3$ ; about 4.5 to about 5.5  $\text{Na}_2\text{O}$ ; and at least one fining agent (page 2, lines 15-21 and page 3, lines 15-23).

Additionally, the invention can relate to a glass consisting of, in percent by weight, based on oxide: about 78.5 - about 79.5  $\text{SiO}_2$ , about 13.0 - about 14.0  $\text{B}_2\text{O}_3$ , about 2.0 - about 3.0  $\text{Al}_2\text{O}_3$ , about 4.5 - about 5.5  $\text{Na}_2\text{O}$ , and 0 - about 0.6  $\text{K}_2\text{O}$ .

The invention, as discussed above, provides:

- a glass which requires less melting energy, i.e., a glass having low melting and working points;
- adequate thermal shock resistance for the production of heat-resistant beverage containers;
- a high chemical resistance similar to that of borosilicate glasses 3.3; and
- a colorless glass.

Page 2, lines 10 - 15 and page 3, lines 15-23.

### **VI. Grounds of Rejection to be Reviewed on Appeal**

The following grounds are respectfully requested to be reviewed on Appeal:

1. The application priority claim and the specification stand objected. As discussed below, Appellants respectfully request review by the Board of the objection to the priority claim because the Examiner is applying a written description rejection pursuant 35 U.S.C §112 under the guise of this objection, and then rejecting the claims based on denial of the priority claim. (See item 3 immediately below.) Once the priority claim objection is resolved, so can the specification objection.

2. Claims 5, 8, and 9 stand rejected under 35 U.S.C §102(b) as allegedly being anticipated by U.S. Patent No. 5,288,668 (Netter).

3. Claims 1 - 20 stand rejected under 35 U.S.C §102(b) as allegedly being anticipated by GB 2348197 (GB) or JP 2000-29037 (JP).

### **VII. Arguments**

In the Decision by the Board of Patent Appeals and Interferences mailed 16 September 2003 in prior application number 09/532,966, the Board held that the term “colorless” was not supported by the specification because Appellants had not submitted any evidence in support of their arguments. Subsequently, Appellants filed the present continuation application and provided evidence in the form of a declaration, a sample and attachments on 26 October 2004. The Examiner improperly maintained an objection to the application’s priority claim despite the fact new evidence was provided that was not before the Board in the prior application, whereby *res judicata* is not applicable.

The Petition Decision of 19 August 2005 denied Appellants’ petition of that objection. But Appellants respectfully submit that the Petition Decision is erroneous because the Decision improperly evaluated the substance of the evidence, while substituting the Director’s own unsupported statement of fact directly contrary to the declarant’s oath-based statement. This improper procedure has resulted in contrary findings between the Director and the Examiner, and as such, is arbitrary and capricious.

The Board clearly has jurisdiction to review this matter because it underlies Rejection (3.) above.

### Priority

The Examiner has cited GB or JP as anticipating claims 1 - 21. Appellants respectfully submit that the present application has an effective priority date of U.S. App. No. 09/532,966 filed 22 March 2000, predating these references. Thus, these references are not prior art with respect to the present claims.

Appellants petitioned this matter since it was made also under the guise of an objection (as well as a specification objection) on 11 March 2005. On 19 August 2005, a Decision denied that petition.

Preliminarily, the issue of whether Appellants complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C §120 was not before the Board in the prior decision. The issue before the Board was a rejection under 35 U.S.C §112 of whether the specification supported the term "colorless" in a claim. Consequently, whether the claims of the present application have a priority claim is not subject to *res judicata*. Therefore, it is improper for the Examiner to deny Appellants' priority claim a priori, but must weigh the issue of the term "colorless" in view of the new evidence.

In the Petition Decision of 19 August 2005, the Director determined that a glass beaker provided as evidence was "colorless" because it had a green/grey edge coloration. However, this finding is contrary to (a) the Examiner's own conclusion based on the declaration, made in the Final Office Action mailed 24 November 2004, who determined that the sample was colorless (see page 2 of the Final Office Action mailed 24 November 2004); and (b) the declarant's (i) own conclusion and supporting independent evidentiary exhibit showing that the beaker is "colorless" (page 3 of the declaration, 2<sup>nd</sup> paragraph and supporting exhibit), and (ii) explanation that edge coloring is not relevant to the term "colorless" but, rather, only "a view through the panel" (paragraph bridging pages 3 and 4) is relevant. (The Board might take judicial notice of glass window panels commonly purchased in hardware stores which would unambiguously be agreed to be colorless, but, yet, often appear green tinted upon an edge view.) The Director has offered no support for the position taken in the Declaration.

To the extent the Director seems to imply that if the glass had been colorless (which it is), "colorless" would be supported, then the subject term is supported in the specification.

In any event, the record clearly establishes that the specification supports the term "colorless" under 35 U.S.C. §112, first paragraph.

The specification at page 3 provides:

It is also possible for decolorants, such as, for example  $\text{Er}_2\text{O}_3$

or CoO, to be included, which counteract or hide the coloring effect of iron which is usually present in the raw materials.

Emphasis added.

The Examiner alleges “that the terminology ‘decolorant’ in the disclosure encompasses compounds that counteract the effect of iron even if the effect is the addition of a color. Both decolorants listed in the instant disclosure are known to have a coloring effect.” The Examiner concludes in the Action that Appellants “have not shown by way of tangible evidence that the addition of the listed decolorants still results in a colorless glass.” The Examiner in the Advisory Action expands on this rationale by asserting that the terms “counteract” or “hide” do not equate to a colorless glass.

Appellants respectfully submit that these assertions are erroneous and ignore the declaration. The declaration was submitted in part to establish that one of skill in the art would readily recognize that the glass at page 2 is colorless. A decolorant does not form a colorless glass in this case because the glass is inherently colorless. That fact in and of itself supports the inherent disclosure of “colorless” in the specification.

The rationale by the prior Board panel for sustaining the rejections was that Appellants failed to establish that a glass as disclosed at, e.g., page 2 of the specification, was in fact colorless. But, the declaration provides more than sufficient evidence that such a glass is colorless.

As for the optional decolorants, these are added only if a glass contains impurities, such as iron. See the passage quoted above from page 3 of the specification and page 4, first full paragraph of page 4 of the declaration. The declarant further explains that, contrary to the examiner’s unsupported allegation, “one of ordinary skill in the art would readily recognize that balancing two colors, one of which is a result of an impurity and the other a result of adding a decolorant, can provide a colorless glass.” (See, declaration, page 4, lines 10-16.) The contrary allegation of the examiner underlies the rejection. Giving proper weight to the declarant’s statements removes this basis for holding the specification not to inherently disclose that the invention’s glasses are colorless. Note the term “counteract” which means “neutralize” or “undo the effect of with opposing action.” This is only reasonably interpretable in context to mean neutralize the coloring effect of, etc., i.e., render colorless. (Even if the alternative term “hide” could arguably be more broadly interpretable to include masking a coloring effect by a color change (not admitted, e.g., in view of the context of use), this would not impact the existence of the concept of colorlessness due to the other term employed.)

### Claim Rejections Under 35 U.S.C §102 based on Netter

Netter does not disclose a “colorless” glass as the term is properly interpreted.

#### *Claims 5 and 9*

With respect to claim 5, Appellants respectfully submit that the declaration establishes that the manganese oxide of Netter is a colorant, not a decolorant. As discussed above, this evidence was not before the Board in deciding the appeal in the parent application, thus *res judicata* does not apply.

As explained, a decolorant used in the context of the present invention would remove color imparted by an impurity to return the glass to its intended inherent state, i.e., a colorless glass. As the declarant fully explains in the paragraph bridging pages 4 and 5, Netter’s use of manganese oxide does not constitute the use of a decolorant which renders a glass colorless. Thus, Appellants respectfully submit that Netter does not anticipate the invention as defined by claim 5.

The allegation by the Examiner that the showing in the declaration is not commensurate in scope with claim 5 is not relevant to the issue here. The declaration establishes that the manganese oxide in Netter is not a “decolorant.” The declaration is not a showing of unexpected properties of the claimed invention but a showing that the prior art does not meet an element of the claim. The scope of the showing with regard to Appellants’ claim is not relevant to this issue.

#### *Claim 8*

With respect to the terminology “consisting essentially of” in claim 8, Appellants respectfully submit that this terminology excludes materials that would materially affect the basic and novel characteristics of the claimed glass. The prior Board Decision concluded that the composition of the glass defined in that claim was not necessarily colorless. However, the present evidence was not before the Board which establishes that such a glass is indeed colorless and would be recognized as such.

Also, the declaration provides evidence that MnO<sub>2</sub> in such amounts as used in Netter acts as a colorant, and as such, would affect the basic and novel characteristics of the “colorless” glass as defined by claim 8. Consequently, Appellants respectfully submit that claim 8 is patentable over Netter in view of this newly submitted evidence.

### Rejections based on GB 2348197 (GB) and Japanese document 2000-290037 (JP).

*Claims 1 - 21*

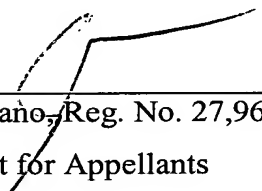
Appellants respectfully submit that the present claims have an effective filing date of the parent application No. 09/532,966, filed March 22, 2000, as discussed above. Consequently, Appellants respectfully submit that these rejections should be withdrawn.

*Claim 20*

Even assuming the present application is a continuation-in-part of the parent application, Appellants respectfully submit that claim 20 has support in the specification of the parent application no. 09/532,966 at, e.g., page 2. As such, Appellants respectfully submit that GB and JP are not prior art with respect to this claim for this reason also.

The Commissioner is hereby authorized to charge any additional fees associated with this response, and not included herewith, or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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Attorney Docket No.: **SGW-0097-C02**

Date: **August 24, 2005**

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### VIII. Claim Appendix

1. (Original) A glass comprising in % by weight, based on oxide: SiO<sub>2</sub> about 78.5 - about 79.5, B<sub>2</sub>O<sub>3</sub> about 13.0 - about 14.0, Al<sub>2</sub>O<sub>3</sub> about 2.0 - about 3.0, Na<sub>2</sub>O about 4.5 - about 5.5, K<sub>2</sub>O 0 - about 0.6, and optionally at least one fining agent; wherein the glass is colorless.

2. (Original) The glass according to claim 1 incorporated into a teapot, a coffee machine jug or a baby-milk bottle.

3. (Original) The glass according to claim 1, further comprising: no more than about 0.5% by weight of a non-interfering oxide.

4. (Original) The glass according to claim 1, wherein the glass has a coefficient of linear thermal expansion  $\alpha_{20/300}$  between about 3.5 and about  $3.7 \cdot 10^{-6}/K$ , a working point  $V_A$  of  $\leq$  about 1220 °C, a modulus of elasticity of  $\leq$  about 65 GPa, a hydrolytic resistance in accordance with DIN ISO 719 in hydrolytic class 1, an acid resistance S in accordance with DIN 12 116 in acid class 1, and a caustic lye resistance L in accordance with DIN ISO 659 in lye class 2.

5. (Original) A glass comprising in % by weight, based on oxide:  
about 78.5 to about 79.5 SiO<sub>2</sub>;  
about 13.0 to about 14.0 B<sub>2</sub>O<sub>3</sub>;  
about 2.0 to about 3.0 Al<sub>2</sub>O<sub>3</sub>;  
about 4.5 to about 5.5 Na<sub>2</sub>O; and



a decolorant.

6. (Original) A process for making glass comprising melting together:  
about 78.5 to about 79.5 weight percent based on oxide  $\text{SiO}_2$ ;  
about 13.0 to about 14.0 weight percent based on oxide  $\text{B}_2\text{O}_3$ ;  
about 2.0 to about 3.0  $\text{Al}_2\text{O}_3$  weight percent based on oxide; and  
about 4.5 to about 5.5  $\text{Na}_2\text{O}$  weight percent based on oxide; wherein the glass is colorless.

7. (Original) The process according to claim 6 further comprising heating the oxides in a heated melting unit to no more than about 1620 degrees Celsius.

8. (Original) A glass consisting essentially of in % by weight, based on oxide:

about 78.5 to about 79.5  $\text{SiO}_2$ ;  
about 13.0 to about 14.0  $\text{B}_2\text{O}_3$ ;  
about 2.0 to about 3.0  $\text{Al}_2\text{O}_3$ ;  
about 4.5 to about 5.5  $\text{Na}_2\text{O}$ ; and  
at least one fining agent.

9. (Original) A thermal shock-resistant container comprising the glass according to claim 5.

10. (Original) A glass made by the process according to claim 6.

11. (Original) A glass according to claim 1, further comprising a decolorant.
12. (Original) A process according to claim 6, wherein the glass further comprises a decolorant.
13. (Original) A glass according to claim 5, wherein the decolorant is  $\text{Er}_2\text{O}_3$ ,  $\text{CoO}$ , or a combination thereof.
14. (Original) A glass according to claim 11, wherein the decolorant is  $\text{Er}_2\text{O}_3$ ,  $\text{CoO}$ , or a combination thereof.
15. (Original) A process according to claim 12, wherein the decolorant is  $\text{Er}_2\text{O}_3$ ,  $\text{CoO}$ , or a combination thereof.
16. (Original) A glass according to claim 1, wherein the optional fining agent is  $\text{As}_2\text{O}_3$ ,  $\text{Sb}_2\text{O}_3$ ,  $\text{NaCl}$ ,  $\text{KCl}$ , or a combination thereof.
17. (Original) A glass according to claim 3, wherein the non-interfering oxide is  $\text{MgO}$ ,  $\text{CaO}$ , or a combination thereof.
18. (Original) A glass according to claim 1, consisting essentially of  $\text{SiO}_2$  about 78.5 - about 79.5,  $\text{B}_2\text{O}_3$  about 13.0 - about 14.0,  $\text{Al}_2\text{O}_3$  about 2.0 - about 3.0,  $\text{Na}_2\text{O}$  about 4.5 - about 5.5,  $\text{K}_2\text{O}$  0 - about 0.6, in % by weight based on oxide, and a fining agent.

19. (Original) A teapot, coffee machine jug or baby milk bottle consisting essentially of a glass according to claim 1.

20. (Original) A glass consisting of in % by weight, based on oxide:

$\text{SiO}_2$  about 78.5 - about 79.5;

$\text{B}_2\text{O}_3$  about 13.0 - about 14.0;

$\text{Al}_2\text{O}_3$  about 2.0 - about 3.0;

$\text{Na}_2\text{O}$  about 4.5 - about 5.5; and

$\text{K}_2\text{O}$  0 - about 0.6.

**IX. Evidence Appendix**

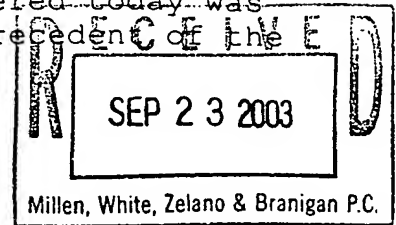
Attached is a declaration of 26 October 2004 and accompanying documents.

**X. Related Proceedings Appendix**

Attached is a Decision by the Board of Patent Appeals and Interferences mailed 16 September 2003 in prior application number 09/532,966.

5EW-97

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.



Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

SEP 16 2003

PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

*Ex parte* CHRISTIAN KUNERT,  
JOHANNES RUTTIGERS, ROLAND LEROUX and PETER BRIX

Appeal No. 2003-0694  
Application No. 09/532,966

HEARD: August 21, 2003

Before KIMLIN, JEFFREY T. SMITH, and POTEATE, *Administrative Patent Judges*.

POTEATE, *Administrative Patent Judge*.

**DECISION ON APPEAL**

This is an appeal under 35 U.S.C. § 134 from the examiner's refusal to allow claims 1-12, 14-17 and 19-20.

DKT-D  
9/23/03  
[Signature]

Claim 13, also pending in the application, stands objected to as dependent on a rejected base claim but has been indicated as allowable if rewritten in independent form to include the limitations of the base claim and any intervening claims.

Claims 1, 5 and 8 are representative of the subject matter on appeal and are reproduced below:

1. A glass comprising in % by weight, based on oxide:  $\text{SiO}_2$  about 78.5 - about 79.5,  $\text{B}_2\text{O}_3$  about 13.0 - about 14.0,  $\text{Al}_2\text{O}_3$  about 2.0 - about 3.0,  $\text{Na}_2\text{O}$  about 4.5 - about 5.5,  $\text{K}_2\text{O}$  0 - about 0.6, and optionally at least one fining agent; wherein the glass is colorless.

5. A glass comprising in % by weight, based on oxide:

about 78.5 to about 79.5  $\text{SiO}_2$ ;  
about 13.0 to about 14.0  $\text{B}_2\text{O}_3$ ;  
about 2.0 to about 3.0  $\text{Al}_2\text{O}_3$ ;  
about 4.5 to about 5.5  $\text{Na}_2\text{O}$ ; and  
a decolorant.

8. A glass consisting essentially of in % by weight, based on oxide:

about 78.5 to about 79.5  $\text{SiO}_2$ ;  
about 13.0 to about 14.0  $\text{B}_2\text{O}_3$ ;  
about 2.0 to about 3.0  $\text{Al}_2\text{O}_3$ ;  
about 4.5 to about 5.5  $\text{Na}_2\text{O}$ ; and  
at least one fining agent.

The reference relied upon by the examiner is:

Netter

5,288,668

Feb. 22, 1994

**GROUND OF REJECTION**

1. Claims 1-4, 6, 7, 10-12 and 14-20 stand rejected under 35 U.S.C. § 112, first paragraph.<sup>1</sup>

We affirm.

2. Claims 5, 8 and 9 stand rejected under 35 U.S.C. § 102(b) as anticipated by Netter.<sup>2</sup>

We affirm.

The invention relates to a glass that may be used for manufacturing thermal shock-resistant beverage containers. Specification, page 1, lines 1-2. The type of glass for use in this type of container must be characterized by good chemical resistance and high thermal shock resistance arising from a low coefficient of thermal expansion and a low modulus of elasticity.

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<sup>1</sup>The rejection of claim 19 under 35 U.S.C. § 112, second paragraph, has been obviated by appellants' amendment to claim 19 (see Paper No. 10, received January 25, 2002). Appeal Brief, Paper No. 15, received April 25, 2002, page 6; Examiner's Answer, page 2, paragraph (4).

<sup>2</sup>The rejection of claims 1-4, 6, 7, 10-12 and 14-20 under 35 U.S.C. § 102(b) as anticipated by Netter has been withdrawn in view of appellants' argument that Netter fails to teach a colorless glass. Examiner's Answer, Paper No. 16 [sic, 21], mailed September 5, 2002, page 4, second paragraph.



*Id.*, lines 4-7. In order to achieve these requirements, it is known in the art to utilize borosilicate glasses which are suitable for use in laboratory applications. See *id.*, lines 10-16. However, these glasses suffer from the drawback that they require significantly more energy and more expensive raw materials than are required for the production of conventional soda-lime glasses. See *id.*, page 1, line 26 - page 2, line 2. According to appellants, they have discovered a glass which provides adequate thermal shock resistance for the production of heat-resistant beverage containers yet requires less melting energy than is required for borosilicate glasses. *Id.*, page 2, lines 11-14.

#### **DISCUSSION**

***Rejection of claims 1-4, 6, 7, 10-12 and 14-20  
under 35 U.S.C. § 112, first paragraph***

According to the examiner, the terminology "wherein the glass is colorless" which appears in independent claims 1 and 6 is new matter. Examiner's Answer, page 3. Appellants argue that support for this terminology may be found at page 3 of the Specification. Appeal Brief, page 5. In particular,

appellants rely on the following sentence as support for their contention that the term "colorless" used in the claims is fully supported by the specification:

It is also possible for decolorants, such as, for example,  $\text{Er}_2\text{O}_3$  or  $\text{CoO}$ , to be included, which **counteract or hide** the coloring effect of iron which is usually present in the raw materials.

Specification, page 3, lines 21-23.

The examiner takes the position that the above language from the specification does not provide support for a "colorless" glass. Examiner's Answer, page 4. Rather, the examiner maintains that this language merely supports the idea that the coloring effect of iron in the glass may be counteracted or hidden, such that the glass may still have a color. *Id.*

The test for determining compliance with the written description requirement of 35 U.S.C. § 112, first paragraph, is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession of the later claimed subject matter at the time of the invention, rather than the presence or absence of literal support

in the Specification for the claim language. *See Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1116-17 (Fed. Cir. 1991) and *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). As explained by the Court in *Vas-Cath*, 935 F.2d at 1563-64, 19 USPQ2d at 1117:

35 U.S.C. § 112, first paragraph, requires a "written description of the invention" which is separate and distinct from the enablement requirement. The purpose of the "written description" requirement is broader than to merely explain how to "make and use"; the applicant must also convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession *of the invention*. The invention is, for purposes of the "written description" inquiry, *whatever is now claimed*.

Appellants urge that one of ordinary skill in the art would readily understand that the effect of a "decolorant" is to cause physical decoloration. Appeal Brief, page 5. In support of their position, appellants present dictionary definitions of the terms "decolorant," "colorless," and "bleach." See Reply Brief, Paper No. 22, received November 5, 2002. Appellants further submit that one skilled in the art would immediately understand the glass composition disclosed on page 2 of the

Specification as being colorless. Appeal Brief, page 5.  
Appellants further submit that their position is supported by references entitled "GLASS - Nature, Structure and Properties" and "Fabrication Faults in the Glass Industry." *Id.*, page 6.

Like the examiner, we do not find appellants' arguments persuasive. With respect to the dictionary definition of the term "decolorant," we note that terms in a patent claim are given their ordinary meaning as used in the field of the invention *unless* the text of the patent indicates that a word has special meaning. *See Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001). In this case, we find that the inventors have set forth an explicit definition for the term "decolorant" in the patent specification which is contrary to the dictionary definition of "decolorant" now proposed by appellants. As pointed out by the examiner, appellants clearly define a decolorant as a compound which "counteract[s] or hide[s]" the effect of iron. Examiner's Answer, page 3. This definition does not require that the glass be rendered "colorless." *See id.*

We are also unpersuaded by appellants' argument that one of skill in the art would understand the glass at page 2 of

the Specification as being colorless. Appellants have provided absolutely no evidence in support of their contention. Mere attorney argument is insufficient to overcome the examiner's *prima facie* showing that the claims are unpatentable under 35 U.S.C. § 112, first paragraph.

Finally, we are in agreement with the examiner that the cited references merely disclose the balancing of two colors which does not require a glass to be colorless. See Examiner's Answer, page 5.

Accordingly, the rejection is affirmed.

***Rejection of Claims 5, 8 and 9 under 35 U.S.C.  
§ 102(b) as Anticipated by Netter***

***1. Claims 5 and 9***

The examiner found that Netter discloses the invention as claimed, the decolorant being manganese oxide which "counteracts or hides" the coloring effect of iron. See Examiner's Answer, page 5. Although Netter does not specifically refer to manganese oxide as a "decolorant," we note that Netter is directed to providing a pink-color for a silicate glass that hides, or counteracts, the yellow or yellow-green color resulting from iron impurities. See Netter, column 1, lines 8-48.

Appellants' sole argument in traversing the rejection of claims 5 and 9 is that "Netter fails to teach including a decolorant, at least in part because Netter teaches a pink glass." Appeal Brief, page 7. Having found that the term "decolorant" does not require that the glass is colorless, we are unpersuaded by appellants' argument.

The rejection is affirmed.

2. Claim 8

With respect to claim 8, appellants argue that the phrase "consisting essentially of" excludes materials which would affect the basic and novel color characteristics of its glass compositions. Appeal Brief, page 7. Thus, appellants maintain that Netter cannot anticipate claim 8 because Netter fails to exclude materials which add color to his glass compositions. However, for the reasons stated above, we are not persuaded that the composition as recited in claim 8 is necessarily "colorless" and the claim does not specifically recite that the glass is "colorless."

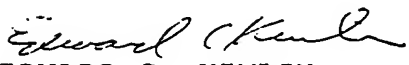
Accordingly, the rejection is affirmed.

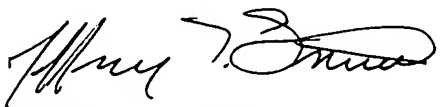
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**TIME PERIOD FOR RESPONSE**

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

**AFFIRMED**

  
EDWARD C. KIMLIN )  
Administrative Patent Judge )

  
JEFFREY T. SMITH )  
Administrative Patent Judge )

  
LINDA R. POTEATE )  
Administrative Patent Judge )

BOARD OF PATENT  
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Application 09/532,966

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